



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,727	12/10/2003	Dhrubajyoti Borthakur	5760-18500	6701

35690 7590 10/30/2007  
MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.  
P.O. BOX 398  
AUSTIN, TX 78767-0398

EXAMINER
----------

MIZRAHI, DIANE D

ART UNIT	PAPER NUMBER
----------	--------------

2165

MAIL DATE	DELIVERY MODE
-----------	---------------

10/30/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/732,727

Applicant(s)

BORTHAKUR ET AL.

Examiner

Diane Mizrahi

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

DIANE MIZRAHI  
PRIMARY EXAMINER

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Claims 1-21 are pending in this present application. In response to Applicant's remarks of August 8, 2007, all previous presented rejections of the claims are hereby withdrawn as to being moot. See new office action below:

Examiner maintains the rejection of claims 15-21. Applicant has not overcome the USC 101 conditional limitations. See office action below:

**Claim Rejections - 35 USC 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 15-21 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, the claims are not directed towards the final result that is "useful, tangible and concrete.

See State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02 and Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557). The decisions state to be eligible for patent protection, the claimed invention as a whole must accomplish a practical application. A claim limited to a machine or manufacture, which has a practical application, is statutory. Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557). That is, it must produce a "useful, concrete and tangible result". The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383

Art Unit: 2165

U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966); In re Fisher, 421 F.3d 1365, 76 USPQ 2d 1255 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ 2d 1600, 1603-06 (Fed. Cir. 1993).

Claims 15-21 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter. Independent claim 15 is read as specifying an transmission .... signal. Claims 16-21 inherit this rejection by their pendency from claim 24. Specifically, in its broadest reasonable interpretation, independent claim 24, as amended, specifies software (functional descriptive material) embedded in a signal, which is energy. Energy per se lacks a physical article of object. Accordingly, the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 U.S.C. 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category and it is not capable of producing a practical application of the idea embodied in the software program.

Applicant's specification [paragraph 0021] states, "system memory 25 may be one embodiment of a computer-accessible medium configured to store such program instructions and data. However, in other embodiments, program instructions and/or data may be received, sent or stored upon different types of computer-accessible media. Generally speaking, a computer-accessible medium may include storage media or memory media such as magnetic or optical media, e.g., disk or CD-ROM included in storage system 10 as storage devices 30. A computer-accessible medium may also include transmission media or signals such as electrical, electromagnetic, or digital signals, conveyed via a communication medium such as network

Art Unit: 2165

and/or a wireless link, which may be included in some embodiments of storage system 10 as system interconnect 40.”

Examiner asserts that “Energy per se lacks a physical article of object” and “As such, they fail to fall within is a statutory category and it is not capable of producing a practical application of the idea embodied in the software program”.

The Official Action of November 17, 2006 is in full compliance with USPTO’s Guidelines for Examination of Computer Related Inventions and reflects office policy regarding these Guidelines.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 8 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner is not clear as to the new added limitations, “programming-language independent interface... configured to receive a request to access.. file system content...without dependence on a programming language in which the application is implemented” (i.e. claim 1). Examiner reviewed Applicant’s specification and could not find the claimed, “programming-language independent interface.. configured to receive a request to access.. file system content...without dependence on a programming language in which the application is implemented” explained. Examiner requests for Applicant to point out where this is taught. Further clarification is required. For purposes of examination, Examiner will

Art Unit: 2165

interpret such limitation as "the contents of file 310 without issuing an identity-modifying operation to the file". See rejection below:

Regarding the rejection under double patenting, Examiner formally withdraws this rejection.

**Claim Rejections - 35 U.S.C. 102**

Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Borthakur et al. (US Publication No. 200501144406 A1 and Borthakur hereinafter). The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claims 1-21 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 10/723,729 which has a common inventors with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application. 10/723,729. This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1,132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate

Art Unit: 2165

showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Regarding Claims 1,8, and 15 Borthakur teaches a storage device configured to store a plurality of files, (abstract), a host device [0023] configured to implement [0024] a file system wherein the file system is configured to manage access [0007] to said storage device and to store file system content on said storage device [0024], wherein said file system comprises a programming-language-independent interface (i.e. SCSI and ATAPI interfaces) [0034] through which an application is configured to access said file system content [0024] [0034].

Regarding the new limitation, “programming-language independent interface... configured to receive a request to access.. file system content...without dependence on a programming language in which the application is implemented”, Borthakur teaches this which reads on the “the contents of file 310 without issuing an identity-modifying operation to the file” (Borthakur, [0049]).

Regarding Claims 2,9, and 16, Borthakur teaches wherein said file system/content comprises file data stored in one or more of said plurality of files [0007][0034][0038]. Regarding Claims 310, and 17, Borthakur teaches wherein said file system content comprises metadata stored in a named stream corresponding to a given file [0082][0048]0034].

Regarding Claims 4,11, and 18 Borthakur teaches.... metadata is stored in XML format [0061].

Regarding Claims 5,12, and 19 Borthakur teaches detect a virtual file identity corresponding to a given file [0043][0045][0046]; select at least a portion of said file system

Art Unit: 2165

content dependent on said virtual file identity [0089][0078]; and return said selected file content (i.e. retrieve records) [0095].

Regarding Claims 6,13, and 20 Borthakur teaches virtual file identity is formed by embedding a command token within a file identity corresponding to said given file [0045].

Regarding Claims 7,14, and 21 Borthakur teaches wherein said virtual file identity is formed by prepending a virtual directory to a file identity corresponding to a given file (i.e. "filename.txt") [0040].

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. (See MPEP 2123.)

#### **Other Prior Art Made of Record**

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. U.S. patents and U.S. patent application publications will not be supplied with Office actions. Examiners advises the Applicant that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. For the use of the Office's PAIR system, Applicants may refer to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.



Art Unit: 2165

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D. Mizrahi whose telephone number is 571-272-4079. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 305-3900 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

---

Diane Mizrahi  
Primary Patent Examiner  
Technology Center 2100

October 20, 2007